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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/300,320	04/27/1999	JOHN ANDREW COOK	AT9-99-159	4309
35525	7590	03/18/2004	EXAMINER	
DUKE W. YEE CARSTENS, YEE & CAHOON, L.L.P. P.O. BOX 802334 DALLAS, TX 75380			HOOSAIN, ALLAN	
			ART UNIT	PAPER NUMBER
			2645	20
DATE MAILED: 03/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/300,320	COOK ET AL.
Examiner	Art Unit	
Allan Hoosain	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 16 February 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-7, 10-22 and 25-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-7, 10-22 and 25-33 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 19.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## **FINAL DETAILED ACTION**

### ***Claim Objections***

1. Claims 11-12 are objected to because of the following informalities: Claim 11 depends on Claim 12 and Claim 12 depends on Claim 10. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7,14-22,29-30,32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by **Sonnenfeld** (US 6,112,049).

As to Claims 1,3,16,18, with respect to Figure 1, **Sonnenfeld** teaches a method in a data processing system for processing explanation voice clips (voice messages), the method comprising the data processing system implemented steps of:

responsive to a request from a test designer (user ) to record an explanation voice clip (voice message), presenting a graphical user interface for composing a test (text message), wherein the graphical user interface includes a test taker (recipient field) for entering a recipient

address and controls for recording an explanation voice clip (voice message) (Col. 56, lines 25-32);

responsive to the user entering a recipient address in the recipient field and recording a voice message using the controls, forming a text message to be sent to the recipient address (Col. 56, lines 33-42);

responsive to a request to send the text message, automatically inserting an explanation HTML tag (indicator) into the text message indicating a presence of a voice clip (voice message) (Col. 16, lines 60-66, Col. 42, line 66 through Col. 43, line 16);

responsive to the request to send the text message, automatically appending the voice message to the text message to form an appended voice message (Col. 56, lines 25-54); and

sending the text message with the appended voice message to the recipient address (Col. 56, lines 33-54).

As to Claims 2,17, **Sonnenfeld** teaches the method of claim 1 further comprising:

receiving the test (text message) to form a received text message (Col. 66, lines 30-37);

parsing the received test (text message) for a presence of a HTML tag (an indicator) indicating that the received text message has an explanation voice clip (is a voice message) (Col. 43, lines 12-16); and

responsive to a presence of the indicator, presenting controls to listen to the voice message (Col. 43, lines 9-12).

As to claims 4,19, **Sonnenfeld** teaches the method of claim 1, wherein the indicator is a HTML tag (text string) (Col. 42, lines 66-67).

As to Claims 5-7 and 20-22, **Sonnenfeld** teaches the method of claim 1, wherein the data processing system is a personal computer (Figure 1 and Col. 11, lines 55-57).

As to Claim 32, **Sonnenfeld** teaches the method of claim 1, wherein the step of automatically inserting an indicator into a text message comprises inserting the indicator into a body of the text message (Col. 43, lines 3-10).

As to Claim 33, **Sonnenfeld** teaches the data processing system of claim 16, wherein the inserting means comprises means for inserting the indicator into a body of the text message (Col. 43, lines 3-10).

As to Claims 14,29, with respect to Figure 1, **Sonnenfeld** teaches a messaging system for use in a data processing system, the messaging system comprising:

    a graphical user interface, wherein the graphical user interface provides selections for test designer (user) input to create and send sound clips (voice messages) (Col. 16, lines 64-67); and  
    an Interactive Testing System (ITS) (message processing mechanism), wherein the message processing mechanism has a plurality of modes of operation including (Col. 15, lines 50-54):

a first mode of operation in which the message processing mechanism waits for a user input (Col. 17, lines 1-8);

a second mode of operation, responsive to a user input in the first mode of operation to record a sound clip (voice message), in which the message processing mechanism presenting a graphical user interface for composing a summary (text message), wherein the graphical user interface includes a test taker (recipient field) for entering a recipient address and controls for recording a sound clip (voice message) (Col. 14, lines 31-35 and Col. 19, lines 33-48);

a third mode of operation, responsive to a user input in the first mode of operation to enter a recipient address for the voice message, in which the message processing mechanism receives entry of a recipient address for the voice message (Col. 19, lines 33-48);

a fourth mode of operation, responsive to a user recording the voice message using the controls, in which the message processing mechanism stores the voice message in a sound clip (file) (Col. 16, lines 64-66); and

a fifth mode of operation, responsive to a user input in the first mode of operation to send the voice message and to a presence of a recipient address for the voice message, in which the message processing mechanism creates a text message, inserts an identifying string that identifies a presence of the voice message in the text message, appends the file to the text message, and sends the text message to the recipient address (Col. 16, lines 60-66 and Col. 43, lines 8-17).

As to Claims 15,30, **Sonnenfeld** teaches the messaging system of claim 14, wherein the message processing mechanism further includes:

a fifth mode of operation in which the message processing mechanism waits for a receipt of an explanation (text message) (Col. 42, lines 66-67 and Col. 43, lines 1-6);

a sixth mode of operation, responsive to receiving a text message, in which the message processing mechanism parses the text message to determine whether HTML tags (an identifying string) identifying a presence of a voice clip (voice message) is present (Col. 43, lines 8-17); and

a seventh mode of operation, responsive to a presence of the identifying string, in which the message processing mechanism causes the graphical user interface to display the message as a voice message in question answers (a message list) (Col. 43, lines 1-8).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-13,25-28,31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Logan et al.** (US 5,721,827).

As to Claims 10,31, with respect to Figures 1 and 5-7, **Logan** teaches a method in a computer for receiving messages, the method comprising:

receiving an I-selection record (first text message) including an image (custom message) of a presentation (first type) (Col. 31, lines 22-36);

parsing the first text message for LocType I (an identifying string) identifying a presence of an Image (custom message) associated with the program record (first text message) (Col. 31, lines 22-36); and

responsive to the presence of the LocType I (identifying string) and responsive to selection of the program record (text message), identifying the presentation (first type) and presenting slide show controls (first controls) to access the image (first custom message) (Col. 10, lines 51-55 and Col. 31, lines 22-36);

receiving a bookmarked passage (second text message) including a voice annotation (second custom message) of an opinion (second type) (Col. 10, lines 51-55 and Col. 31, lines 51-56);

parsing the second text message for LocType L (an identifying string) identifying a presence of a voice annotation (custom message) (Col. 11, lines 26-35 and Col. 31, lines 51-57); and

responsive to a presence of LocType L (an identifying string) in the bookmark (second message), identifying the opinion (second type) and presenting listening (second) controls to access the voice annotation (second custom message) (Col. 11, lines 26-35 and Col. 31, lines 56-60).

As to Claims 11,26, **Logan** teaches the method of claim 12 wherein the first controls comprise controls for presenting the voice message (Col. 31, lines 27-30).

As to Claim 12, **Logan** teaches the method of claim 10, wherein the first custom message is a voice message and the second custom message is a stock trade (Col. 31, lines 27-30 and Col. 37, lines 26-35).

As to Claims 13,28, **Logan** teaches the method of claim 12, wherein the first controls include a play control, back (a rewind control), and skip (a fast forward control) (Col. 14, lines 28-41).

As to Claim 25, with respect to Figures 1 and 5-7, **Logan** teaches a data processing system for receiving messages, the data processing system comprising:

first receiving means for receiving a first text message including a first custom message of a first type (Col. 31, lines 22-37);

first parsing means for parsing the first text message for markers (an identifying string) identifying a presence of a custom message associated with the first text message (Col. 31, lines 27-30);

first displaying means, responsive to the presence of an identifying string in the first text message, for identifying the first type and presenting first controls to access the first custom message (Col. 31, lines 30-37);

second receiving means for receiving a second text message including a second custom message of a second type (Col. 31, lines 51-56);

second parsing means for parsing the second text message for markers (an identifying string) identifying a presence of a custom message (Col. 31, lines 51-56); and

second interface means, responsive to a presence of an identifying string in the second message, for identifying the second type and presenting second controls to access the second custom message (Col. 31, lines 56-60).

As to Claim 27, **Logan** teaches the data processing system of Claim 25, wherein the first custom message is a voice message and the second custom message is a stock trade (Col. 31, lines 27-30 and Col. 37, lines 26-35).

*Response to Arguments*

6. Applicant's arguments filed in the 2/16/04 Remarks have been fully considered but they are not persuasive because of the following:

- (a) The arguments with respect to amended independent claims 1,14,16,29 and their corresponding dependent claims are moot in view of the new grounds of rejections.
- (b) With respect to Claims 10 and 31 and their dependent claims, the arguments appear to suggest that **Logan** does not teach the claimed limitations. Examiner has more clearly indicated in Claim 10, in the instant application, how **Logan** was applied to the claims. In addition, Examiner believes that it would be best if Applicants and Examiner discuss the claims with respect to the disclosure and **Logan**. In this regard, Examiner respectfully invites Applicants to contact Examiner to discuss the claims with the objective of overcoming the prior art of record.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any response to this final action should be mailed to:

**Box AF**  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications; please mark "EXPEDITED PROCEDURE")

**Or:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Allan Hoosain*  
Allan Hoosain  
Primary Examiner  
3/16/04